UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/714,229	06/12/91	ZHOU	Y 49/4 18634/A

EXAMINER

JORDAN, K

ART UNIT	PAPER NUMBER
1205	

WENDEROTH, LIND & PONACK
805 15TH ST., NW
SOUTHERN BLDG., SUITE 700
WASHINGTON, DC 20005

DATE MAILED: 12/07/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 8/27/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 17-25 are pending in the application.
   Of the above, claims ~~NONE~~ are withdrawn from consideration.
2. ☒ Claims 1-16 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 17-25 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Claims 17-25 are pending in this application.

The amendment received on August 27, 1992 has been entered.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 17-25 are rejected under 35 U.S.C. § 103 as being unpatentable over Wang et al. (R) and Sethi et al. (S). The claims appear to be drawn to compositions and methods for treating malaria with benflumetol and arteether analogues. Wang et al. discloses that benflumentol is a known antimalarial drug. Sethi et al. discloses that arteether is a known antimalarial

drug. The claimed subject matter differs from the disclosure of the primary references in claiming the combination of both drugs at the same time for the same purpose and specific amounts to be combined together. It is prima facie obvious to combine two compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. Thus, claims that require no more than mixing together of two known antimalarial drugs set forth prima facie obvious subject matter. (In re Kerkhoven, 205 U.S.P.Q. 1069) The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references.

The applicants remarks and the Wernsdorfer declaration have been considered but are unpersuasive. The expected values in tables 1 and 2 are confusing and unclear. The values do not reflect the "expected" additive effect from combining the observed values for each compound alone. It is not clear as to why the "expected" value are lower than what would be normal for an additive effect. Thus, the results are not clear and a determination of synergism cannot be made. Furthermore, even if the declaration was convincing, the claims are not limited to the organisms or compounds tested. Finally, with regard to synergism, any claims broader in scope than the original

specification, even if shown by the declaration, would not be allowed due to the introduction of new matter.

Claims 20-23 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to ratios of artemether to benflumetol of 1:3 to 1:6 (see p. 10 of the specification). See M.P.E.P. §§ 706.03(n) and 706.03(z).

No claims are allowed.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Jordan whose telephone number is (703) 308-4611.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JORDAN:tce KJ
yDecember 01, 1992

Frederick E. Waddell
Supervisory Patent Examiner
Group 120